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REMARKS

Claims 38-40, 42 and 70 are pending in the subject application. Applicants have hereinabove canceled Figures 23A-1 thru 23E-3 and 28, added replacement Figures 24 and 25, canceled claims 39, 40 and 42 and amended claim 38. Accordingly, upon entry of this Amendment, claims 38 and 70 will be pending and under examination.

In making these amendments, applicants neither concede the correctness of the Examiner's rejections in the August 11, 2003 Final Office Action, nor abandon the right to pursue in a continuing application embodiments of the instant invention no longer claimed in this application. Applicants maintain that these amendments to the specification, claims and drawings do not raise any issue of new matter, and that these claims are fully supported by the specification as originally filed. Accordingly, applicants respectfully request that this Amendment be entered.

In view of the arguments set forth below, applicants maintain that the Examiner's objections and rejections made in the August 11, 2003 Final Office Action have been overcome, and respectfully request that the Examiner reconsider and withdraw same.

Formalities

Drawings

In the Notice of Draftsperson's Patent Drawing Review issued concurrently with the August 11, 2003 Final Office Action, the Draftsperson made certain objections to the drawings, specifically Figures 23A-1 thru 25 and 28, submitted in connection with the subject application.

In response, applicants have canceled Figures 23A-1 thru 23E-3 and 28 and attach hereto, as **Exhibit A**, 2 sheets of new, corrected formal drawings for Figures 24 and 25. Replacement Figure 24 corrects the poor line quality present in the original Figure 24. Replacement Figure 25 corrects the size of numbers, letters and reference characters corrections present in the original Figure 25.

Applicants will amend the specification and Figures in light of the cancellation of Figures 23A-1 thru 23E-3 and 28 in due course.

Rejection Under 35 U.S.C. §112, First Paragraph - Enablement

The Examiner rejected claims 38-40 and 70 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the Examiner states that while being enabling for a method of

generating a tolerogenic antigen presenting cell which comprises: a) contacting the APC with Ts, wherein Tc are CD8+CD28- T cells and b) overexpressing mRNA which encodes an MIR in the APC, wherein MIR is selected from the group recited in claim 39, the specification is not enabling for a method of generating a tolerogenic antigen presenting cell which comprises overexpressing mRNA which encodes any inhibitory MIR in the APC.

In response, but without conceding the correctness thereof, applicants note that claims 39, 40 and 42 have been canceled. Thus, the Examiner's rejection of these claims is now moot.

In response to the rejection of claims 38 and 70, without conceding the correctness of the Examiner's position, applicants note that claim 38 has been amended. Claim 38 now recites, in part, "a) contacting an APC with a CD8+CD28- Ts; and b) causing overexpression, in the APC of step (a), of mRNA which encodes *ILT4* (*MIR-10*), *ILT2* (*MIR7*), or *ITL3*, thereby generating a tolerogenic antigen presenting cell (APC)." (emphasis added).

Claim 38, as amended, is limited to the following monocyte inhibitory receptors (MIR): *ILT4* (*MIR-10*), *ILT2* (*MIR7*), and *ITL3*, and is enabled by the specification. (See the Examiner's remarks in the August 11, 2003 Final Office Action, page 3, paragraph no. 4, and page 4, first and second paragraphs). Applicants maintain that the specification provides support for the method of claim 38 wherein *ILT4* (*MIR-10*), *ILT2* (*MIR7*), or *ITL3* is overexpressed. Applicants direct the Examiner's

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attention to page 146, lines 10-29 of the specification which discloses, in relevant part, that ILT4 (MIR-10), ILT2 (MIR7), and ITL3 are upregulated in anergic APCs.

In view of the above remarks, applicants maintain that claims 38 and 70 satisfy the requirements of 35 U.S.C. §112, first paragraph.

Rejection Under 35 U.S.C. §112, Second Paragraph - Indefiniteness

The Examiner rejected claims 38-40, 42 and 70 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner's rejection is based on the assertion that claims 38 and 39 now recite "...inhibitory monocytes inhibitory receptor (MIR)..." and "...inhibitory (MIR)...", respectively, and that such phrases are unclear since the "MIR" abbreviation could either refer to the genus of monocytes inhibitory receptor or to a subgenus of only inhibitory receptors.

In response, but without conceding the correctness thereof, applicants note that claims 39, 40 and 42 have been canceled. Thus, the Examiner's rejection of these claims is now moot.

In response to the rejection of claims 38 and 70, applicants respectfully traverse, noting that amended claims 39 and 70 do not recite the phrases "...inhibitory monocytes inhibitory receptor (MIR)..." or "...inhibitory

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(MIR)...". Thus, the Examiner's rejection of claims 38 and 70 is obviated.

In view of the above remarks, applicants maintain that claims 38 and 70 satisfy the requirements of 35 U.S.C. §112, second paragraph.

New Rejection Under 35 U.S.C. §112, First Paragraph,
Based Upon Amendment

The Examiner also rejected claims 38-40, 42 and 70 under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner's rejection is based on the assertion that written description does not exist for a method reciting "inhibitory monocytes inhibitory receptor".

In response, but without conceding the correctness thereof, applicants again note that claims 39, 40 and 42 have been canceled. Thus, the Examiner's rejection of these claims is now moot.

In response to the rejection of claims 38 and 70, applicants respectfully traverse, again noting that amended claims 39 and 70 do not recite the phrases "inhibitory monocytes inhibitory receptor". Thus, the Examiner's rejection of claims 38 and 70 is obviated.

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In view of the above remarks, applicants maintain that claims 38 and 70 satisfy the requirements of 35 U.S.C. §112, first paragraph.

Summary

Applicants maintain that the claims pending are in condition for allowance. Accordingly, allowance is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee, other than the \$55.00 fee for a one-month extension of time, is deemed necessary in connection with the filing of this Amendment. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,

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12/11/03
Date